UNITED STATES DISTRICT COURT
DISTRICT OF PUERTO RICO

ROY BROWN, Plaintiff, v. LATIN AMERICAN MUSIC CO., INC., et al., Defendants.	Civil No. 05-1242(JAF)

OPINION AND ORDER

Plaintiff, Roy Brown, filed the present complaint against Defendants, Latin American Music Co. ("LAMCO"), and Asociación de Compositores y Editores de Música Latino Americana ("ACEMLA"), seeking declaratory judgment under the Copyright Act of 1909, 17 U.S.C. § 1 (*superceded* by 17 U.S.C. § 101, et. seq. (2006)). Docket Document No. 1. Defendants filed an answer and counterclaim, alleging copyright infringement under the Copyright Act of 1978, 17 U.S.C. § 101, et seq. Docket Document No. 10.

Plaintiff moves for summary judgment as to both Defendants' counterclaim and his own claim for declaratory relief, alleging that the Defendants' copyright claim is unfounded. Docket Document No. 20. Defendants oppose the motion. Docket Document No. 27.

I.

Factual and Procedural Synopsis

Unless otherwise indicated, we derive the following factual summary from the pleadings, statements of facts, and exhibits submitted by the parties in their summary judgment and opposition motions. Docket Document Nos. 1, 10, 20, 27.

Plaintiff, Roy Brown, is a composer and performer who has set a number of poems originally written by Juan Antonio Corretjer to music, and recorded and performed said "musicalizations." Corretjer is the author of the following poems: (1)"En la Vida Todo es Ir"; (2)"Oubao Moin"; (3)"Distancias"; (4)"Inriri Cahuvial"; (5)"El Hijo"; (6)"Andando de Noche Sola"; (7)"Día Antes"; (8)"Ayuburi"; (9)"Diana de Guilarte"; (10)"Boricua en la Luna"; and (11) "De Ciales Soy." In 1988, Plaintiff applied for and received copyright registration for songs based on poems #1-10, crediting Corretjer as the author of the lyrics for the registered songs.

Defendant and counterclaimant LAMCO is a music publisher incorporated in the state of New York that engages in the business of publishing, licensing, and otherwise marketing and exploiting copyrighted compositions. Defendant and counterclaimant ACEMLA is a music performance licensing corporation, organized and existing under the laws of Puerto Rico, in the business of licensing the performance of musical works. In 1999, fourteen years after the death of Corretjer, the poet's heirs assigned the copyright of the

works penned by Corretjer to Defendants. In February 2000, LAMCO obtained copyright registration for the work entitled "Oubao Moin y 17 Obras Más de Juan A. Corretjer," which contained poems #1-11.

On March 4, 2005, Plaintiff filed the present action, requested a declaratory judgment that poem #1, "En la Vida Todo es Ir," entered the public domain upon its publication due to noncompliance with the statutory formalities required by the Copyright Act of 1909, or, alternatively, entered the public domain because its copyright expired twenty-eight years after the date of first publication and was not renewed as required. Docket Document No. 1. Plaintiff additionally requested a declaration that the musical composition "En la Vida todo es ir" is a joint work where Corretjer provided the lyrics and Plaintiff created the music. Id.

On June 16, 2005, Defendants filed an answer and counterclaim, alleging Plaintiff was infringing upon Defendants' rights to eleven poems written by Corretjer, and seeking injunctive relief and monetary damages. Docket Document No. 10.

On January 23, 2006, Plaintiff filed a motion for summary judgment, requesting dismissal of Defendants' counterclaim and seeking the declaratory relief requested in the original complaint. Docket Document No. 20. Defendants filed their opposition on February 10, 2006. Docket Document No. 27.

II.

Motion for Summary Judgment Standard under Rule 56(c)

The standard for summary judgment is straightforward and well-established. A district court should grant a motion for summary judgment "if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law." FED. R. CIV. PRO. 56(c). A factual dispute is "genuine" if it could be resolved in either party's favor, and "material" if it potentially affects the case's outcome. Calero-Cerezo v. United States Dep't of Justice, 355 F.3d 6, 19 (1st Cir. 2004).

The moving party carries the burden of establishing that there is no genuine issue as to any material fact. See Celotex Corp. v. Catrett, 477 U.S. 317, 323 (1986). However, the burden "may be discharged by 'showing'–that is, pointing out to the district court–that there is an absence of evidence to support the nonmoving party's case." See id. at 325. The burden has two components: (1) an initial burden of production that shifts to the non-moving party if satisfied by the moving party; and (2) an ultimate burden of persuasion that always remains on the moving party. Id. at 331.

The non-moving party "may not rest upon the mere allegations or denials of the adverse party's pleading, but . . . must set

forth specific facts showing that there is a genuine issue for trial," FED. R. CIV. P. 56(e), and may not simply rest upon "conclusory allegations, improbable inferences, and unsupported speculation." Cepero-Rivera v. Fagundo, 414 F.3d 124 (1st Cir. 2005) (quoting Rivera-Cotto v. Rivera, 38 F.3d 611, 613 (1st Cir. 1994)). Summary judgment exists "to pierce the boilerplate of the pleadings and assess the proof in order to determine the need for trial." Euromodas, Inc. v. Zanella, 368 F.3d 11, 17 (1st Cir. 2004) (citing Wynne v. Tufts Univ. Sch. of Med., 976 F.2d 791, 794 (1st Cir. 1992)).

III.

Analysis

Plaintiff's motion for summary judgment relies on submitted exhibits meant to show that the disputed poems were in the public domain upon their publication, as they did not conform with statutory requirements under the Copyright Act of 1909. Docket Document No. 20. Alternatively, Plaintiff argues that Defendants' counterclaim is barred under the relevant statute of limitations period. Id. Plaintiff requests that we: (a) summarily dismiss Defendants' counterclaim of copyright infringement; and, relying on the same body of evidence (b) grant summary judgment as to his own motion for declaratory relief. Docket Document No. 20. We examine each issue in turn.

A. Defendants' Copyright Infringement Claim

To establish copyright infringement, a claimant must prove "(1) ownership of a valid copyright, and (2) copying of constituent elements of the work that are original." Lotus Dev. Corp. v. Borland Int'l, 49 F.3d 807, 813 (1st Cir. 1995) (quoting Feist Publ'n, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 361 (1991). The plaintiff bears the burden of proof as to both elements. Id. (citing Grubb v. KMS Patriots, L.P., 88 F.3d 1, 3, 5 (1st Cir. 1996)). According to 17 U.S.C. § 410(c), "[i]n any judicial proceedings the certificate of a registration *made before or within five years after first publication of the work* shall constitute prima facie evidence of the validity of the copyright and of the facts stated in the certificate. The evidentiary weight to be accorded the certificate of a registration made thereafter shall be within the discretion of the court." 17 U.S.C. § 410(c) (2006) (emphasis added).

In support of their claim that they own a valid copyright over the Corretjer poems, Defendants have submitted a registration certificate, effective February 3, 2000, naming Defendant LAMCO as the copyright claimant over the work "Oubao Moin y 17 Obras Mas De Juan Corretjer," which contains the poems in question. Docket Document No. 10, Exh. A. According to the registration certificate, the first publication of the copyrighted work was

February 18, 1979, over twenty years prior to the effective date of the registration certificate. Id.

We do not find Defendants' assertions, even taken in the light most favorable to their case, sufficient to constitute prima-facie evidence of ownership of a valid copyright. Numerous federal courts have held that in cases where, as here, a certificate of registration is registered more than five years after the first publication of the work, the registration does not constitute prima-facie evidence that the copyright is valid, and the party alleging infringement bears the burden to prove validity. See Sem-Torq, Inc. v. K Mart Corp., 936 F.2d 851, 854 (6th Cir. 1991) (where a work was first published in 1982 and the copyright was registered in 1988, the district court was not bound to accept the validity of the copyright); Dollcraft Indus., Ltd. v. Well-Made Toy Mfg. Co., 479 F. Supp. 1105, 1114 (E.D.N.Y. 1978) (where a work falls outside the statutory presumption of 17 U.S.C. § 410(c), plaintiff carries the burden of proving ownership of a valid copyright); Tuff 'N' Rumble Mgmt. v. Profile Records, 1997 U.S. Dist. LEXIS 4186, 6-7 (S.D.N.Y. 1997) (when work published 18 years prior to the registration certificate, plaintiff has the burden of proving the validity of the copyright).

Congress added the five-year § 410(c) time limitation to the Copyright Act of 1979 on the ground that the longer the lapse of time between publication and registration, the less likely to be

reliable are the facts stated in the certificate. 3-12 NIMMER ON COPYRIGHT § 12.11. If the gap between the publication of a work and its subsequent copyright registration is greater than five years, it is within the district court's discretion to determine the evidentiary weight given to the certificate. Cabrera v. Teatro del Sesenta, Inc., 914 F. Supp. 743, 745 (D.P.R. 1995). We find specific reason here to question the facts contained in the certificate, as it states that the first publication of the copyrighted work was February 18, 1979, Docket Document No. 10, Exh. A, but Defendants, in their opposition to Plaintiff's statement of uncontested facts, concede that five of the poems in question - "Andando de Noche Sola," "En la Vida Todo es Ir," "Inriri Cahuvial," "El Hijo," and "Ayuburi" - were first published in 1957. Docket Document Nos. 20-2, 27-2.

In response to Plaintiff's summary judgment motion, Defendants have failed to produce any evidence regarding the validity of the copyrights beyond the questionable certificate. Docket Document No. 10, Exh. A. Instead, Defendants have focused on attacking the evidence presented by Plaintiff, stating that Plaintiff has failed to meet the burden of proof necessary to determine that the poems are in the public domain. Docket Document No. 27. Defendants' strategy is misguided. As counterclaimants, they are Plaintiffs for the charges alleged against Roy Brown, and bear the burden of

proof of establishing the elements of a copyright infringement case. Grubb, 88 F.3d at 3,5.

Having produced nothing but the certificate as evidence of ownership over the copyright they claim Plaintiff has violated, and given that Defendants have conceded that the facts contained in the certificate are not wholly accurate, the court finds the certificate alone insufficient to sustain Defendant-Counterclaimants' burden on summary judgment. See Religious Technology Ctr. v. Netcom On-Line Communication Servs., Inc., 923 F. Supp. 1231, 1241 (N.D. Cal. 1995); Sem-Torq, Inc., 936 F.2d at 854; Johnson, 2000 U.S. Dist. LEXIS 7055, 11-13. Defendants have failed to establish the requisite elements to proceed in their copyright infringement suit and, therefore, Plaintiff Roy Brown's motion for summary judgment as to Defendants' counterclaim is granted.

B. Declaratory Judgment

Plaintiff additionally requests summary judgment on his claims for declaratory judgment that the Corretjer poem "En la Vida Todo es Ir" is in the public domain, and that the musical composition of the same name is a joint work whereby Corretjer provided the lyrics and Plaintiff created the music. Docket Document No. 1. Plaintiff argues that the poem "En la Vida Todo es Ir" is in the public domain as (i) its publication in the collection of poems titled "Yerba Bruja" did not affix notice of copyright as required under

section 10 of the 1909 Copyright Act, and (ii) Corretjer allowed general publication of his poems to occur. Docket Document Nos. 10, 20.

The determination of whether a work entered the public domain prior to January 1, 1978, the effective date of the Copyright Act of 1976, must be made according to the copyright law as it existed before that date. Forward v. Thorogood, 985 F.2d 604, 605 (1st Cir. 1993); Peer Int'l Corp. v. Latin Am. Music Corp., 161 F. Supp. 2d 38, 46 (D.P.R. 2001); Estate of Martin Luther King, Jr., Inc. v. CBS, Inc., 194 F.3d 1211, 1214 (11th Cir. 1999). Prior to the Copyright Act of 1978 going into effect, a work could enter the public domain if the creator allowed a "general publication of his work to occur," - meaning the work was made available to members of the public at large without regard to who they are or what they propose to do with it, Burke v. National Broadcasting Co., 598 F.2d 688, 691 (1st Cir. 1979) (citing Caliga v. Inter Ocean Newspaper Co., 215 U.S. 182, 188 (1909)) - without including a copyright notice. See Milton H. Greene Archives, Inc. v. BPI Communs., Inc., 378 F. Supp. 2d 1189, 1196 (D. Cal. 2005).

Defendants concede that the poem "En la Vida Todo es Ir" was first published in 1957. Docket Document No. 27-2. Defendants argue the evidence provided by Plaintiff to support his allegations - a photocopy of the book cover of the compilation "Yerba Bruja," and the testimony of María Corretjer, the poet's daughter, that the

author circulated his work "freely among friends and acquaintances at his home and at political activities" - is insufficient because it does not establish that the poem was available to the public at large without the requisite copyright notice. Docket Document No. 27.

Plaintiff must prove that the publication of "Yerba Bruja" was general, as "there is no need to affix a copyright notice where there is only limited publication." Milton H. Greene Archives, Inc., 378 F.Supp. 2d at 1197. Although Plaintiff has submitted an affidavit from the Director of the Puerto Rico Collection in the José M. Lázaro Library of the University of Puerto Rico, Docket Document No. 20-3, the affidavit only proves that the collection "Yerba Bruja" located in the University of Puerto Rico library does not contain the copyright notice, but does not settle the matter regarding general or limited publication.

Likewise, the testimony of María Corretjer submitted by Plaintiff does not settle the matter regarding Corretjer's intent to generally publish the poem in question without retaining his copyrights. Docket Document No. 20, Exh. M. We agree with Defendants that María Corretjer's testimonies are generalizations that, on its own, cannot support a declaration that the poem in question is in the public domain. Docket Document No. 27.

Whether the poem "En la Vida Todo es Ir" was generally published without a copyright notice, thus injecting it into the

public domain, is a material issue of fact that must be determined at trial. As such, Plaintiff's motion for summary judgment on his request for declaratory judgment is denied.

IV.

Conclusion

In accordance with the foregoing, we **GRANT IN PART** and **DENY IN PART** Plaintiff Roy Brown's motion for summary judgment. Docket Document No. 20. Defendants' counterclaim alleging copyright infringement is **DISMISSED WITH PREJUDICE**. Docket Document No. 10. Partial judgment shall be entered accordingly.

IT IS SO ORDERED.

San Juan, Puerto Rico, this 8th day of May, 2006.

S/ José Antonio Fusté
JOSE ANTONIO FUSTE
Chief U. S. District Judge